

REMARKS

The Examiner is thanked for the performance of a thorough search and for the telephone interview conducted on March 4, 2008. By this amendment, Claim 1 has been amended. No claims have been added or canceled. Hence, Claims 1–28 are pending in the application.

The amendments to the claims do not add any new matter to this application. Furthermore, the amendments to the claims were made to improve the readability and clarity of the claims and not necessarily for any reason related to patentability. All issues raised in the Office Action are addressed hereinafter.

I. INTERVIEW SUMMARY

Applicants thank the Examiner for the telephone interview conducted on March 4, 2008. Examiner McLean represented the USPTO and Applicants were represented by Karl T. Rees and Marcel Bingham. The parties discussed the differences between Claim 1 and the cited reference, *Schwier*. In particular, Applicants pointed out that *Schwier* does not teach a “merge utility” within the meaning of Claim 1 because *Schwier* never merges documents in a merge format using a merge utility on a computer system. The Examiner agreed that *Schwier* does not disclose a merge utility within the meaning of Claim 1. However, the Examiner expressed his belief that there may be other bases of rejection for Claim 1. Examiner did not specifically state what these bases for rejection might be, and Applicants dispute the existence of such bases for rejection. However, the Examiner did suggest several possibilities for amendments that may produce an allowable claim after another search. In the interest of expediting prosecution, Applicants agreed to file an RCE to enter several clarifying amendments based on the discussion. No agreement on allowable claim language was reached.

II. CLAIM REJECTIONS BASED ON 35 U.S.C. § 102

Claims 1-28 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 7,202,972 to *Schwier*, et al. (hereinafter *Schwier*). Applicants traverse the rejection. Reconsideration is respectfully requested.

INDEPENDENT CLAIM 1

Claim 1, as set forth in the listing of claims, clarifies that the method features:

receiving, at a merge utility executing on a computer system, **a first merge document that is in a merge format;**
 converting a second document from an original format to the merge format to create a second merge document;
 wherein the second document was created by a first document authoring application;
 wherein the step of converting is performed by either the merge utility or the first document authoring application;
 wherein the **second merge document is in the merge format;**
using the merge utility executing on the computer system, **merging the first merge document and the second merge document** to generate a composite merge document; and
after generating the composite merge document, **delivering said composite merge document to an output device;**
 wherein the output device is a device that is different from the computer system;
 wherein the original format is a format that is not supported by the output device, and therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device; and
 wherein **the merge format is a format that is supported by the output device**, and therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device.

For example, a computer system implementing the method of Claim 1 might feature a merge utility. The computer system may also feature a document authoring application. A user might create a document in the document authoring application (i.e. the second document). A user may wish to print this document with a pre-defined watermark. To do so, a user might click on a button that sends the document to the merge utility, along with another document (i.e. the first document, which may be, for example, a watermark). The merge utility would convert the document to a “merge format” capable of being understood by a printer (i.e. PCL). The other document (i.e. the watermark) may already be in this merge format. The two documents are merged together into one (i.e. the composite document). The merge utility may then deliver the composite document directly to the printer for printing.

In *Schwier*, on the other hand, a user creates a **single document** comprising static data and variable data. **Prior to being converted** to a format suitable for printing, a filter event

separates the static data from the filter data. *Schwier*, col. 7, lines 7-17. Separately, the variable data and the static data are converted to a format suitable for printing. *Schwier*, col. 6, lines 49-56. The converted variable data and converted static data **must be sent to a printer separately**. *E.g.*, *Schwier*, col. 6, lines 49-56. The printer stores the static data on the printer for re-use. *Schwier*, col. 6, lines 33-35. The **printer then performs the step of merging** the static data and the variable data back into a single document. *Schwier*, col 6, lines 63-65. The printer must be specially programmed to perform this step.

Thus, *Schwier* fails to teach or suggest a number of features of Claim 1.

(1) Schwier does not disclose “on the computer system, merging [a] first merge document and [a] second merge document” that are in a “merge format.”

For example, *Schwier* does not disclose “using the merge utility executing **on the computer system, merging** the first merge document and the second merge document” within the meaning of Claim 1. Claim 1 specifically requires that “the output device is a device that is different from the computer system.” Claim 1 also specifically requires that the first merge document and the second merge documents are “in a **merge format**,” which is defined to be “**a format that is supported by the output device**.” Thus, for this element of Claim 1 to be satisfied, two documents in a format supported by an output device must be merged on a computer system that is different from the output device.

Schwier does not teach or suggest such a merger. In *Schwier*, inputs are merged on two occasions. First, as relied upon by the Office Action in alleging that *Schwier* disclosed the quoted step, *Schwier* teaches that two inputs are merged at the application level. As depicted in *Schwier* FIG. 2, variable data (Var. 11) is merged with static data (Stat. 12) inside of an application (App. 12) to produce an EMF document (V+S (EMF) 13). This merger, however, does not teach the merging of Claim 1 because neither document is in a “merge format.”

At this point, it may be helpful to clarify several aspects of printing technology. Printing devices only understand (i.e. “support”) documents in certain “raw” formats, such as PCL or PostScript. *See, e.g.*, *Schwier* col. 10, lines 19–24 (Note that Office formats and EMF are not listed as printing languages). These formats are optimized for printing and are not conducive to editing. Thus, documents are typically edited in “original formats” that are more conducive to editing. Operating systems feature components such as printer drivers and spoolers that then convert these documents from their original format to a supported printing

format prior to sending the document to the printer. For example, spooler 50 in *Schwier* converts an EMF document to a printing language. *Schwier* at col. 9, lines 14–24.

Because one skilled in the art would understand these fundamental aspects of printing technology, one skilled in the art would therefore understand that inputs 11 and 12 are not in a format “that is supported by the output device.” Rather, inputs 11 and 12 appear to be in a Word or Excel format or, alternatively, in EMF. See, e.g., *Schwier* at col. 5, lines 30–38 and col. 6, lines 10–14. Neither of these formats is a “merge format” because, to Applicants’ knowledge, no printer or other output device natively supports a Word, Excel, or EMF document. Because neither Var 11 or Stat 12 is in a merge format, *Schwier*’s merger V+S (EMF) 13 cannot be said to teach or suggest “merging the first merge document and the second merge document” within the meaning of Claim 1.

Though not relied upon by the Office Action, *Schwier* teaches to merge inputs a second time when, in FIG. 2, printer 7 merges the PCL streams Var. 15 and Stat. 16 to form V+S 19. Applicants wish to clarify that this second merger also does not teach or suggest the merger of Claim 1. Claim 1 specifically requires the merger to take place “using the merge utility **on the computer system.**” As Claim 1 presently clarifies, the “output device is different from the computer system.” Since printer 7 clearly corresponds to an output device, *Schwier*’s merger V+S 19 takes place on an output device, and not on a computer system that is different from the output device, as required by Claim 1.

(2) *Schwier* does not teach “after generating the composite merge document, delivering said composite merge document to an output device.”

Also, *Schwier* does not teach or suggest “**after generating** the composite merge document, **delivering said composite merge document to an output device.**” The Office Action alleges that “delivering said composite merge document to an output device” is taught in *Schwier*, FIG. 8. Applicants dispute this allegation. FIG. 8 does not teach a “composite merge document” in any sense.

As FIG. 2 clearly shows, the only merged document to which *Schwier*’s output device (printer 7) has access is V+S 19. Applicants have already shown that V+S 19 cannot be a composite merge document because it is not generated as a result of merging, on a computer system, two documents that are in a merge format. Furthermore, even if V+S 19 were a

composite merge document, V+S 19 is never “delivered” to printer 7—rather, printer 7 must generate V+S 19 itself.

Finally, even if V+S 19 could be said to be a composite document “delivered” to printer 7, such delivery could not be said to occur “after generating the composite merge document.” As FIG. 2 makes clear, V+S 19 is generated at printer 7. Therefore, V+S 19 cannot be said to be delivered to printer 7 after V+S 19 has been generated.

For at least the foregoing reasons, *Schwier* fails to teach or suggest at least one element of independent Claim 1. Therefore, *Schwier* does not anticipate Claim 1 under 35 U.S.C. § 102. Reconsideration is respectfully requested.

DEPENDENT CLAIMS 2–28

Claims 2–28 depend from Claim 1, and include each of the above-quoted features by dependency. Thus, *Schwier* also fails to teach or suggest at least one feature found in Claims 2–28. Therefore, *Schwier* does not anticipate Claims 2–28. Reconsideration of the rejection is respectfully requested.

In addition, each of Claims 2–28 recites at least one feature that independently renders it patentable. For example, Claim 13 features, among other elements:

receiving, at the merge utility, **a request to merge documents**;
wherein the steps of **converting** the second document and
merging the first merge document and the second merge
document are both performed **in response** to the merge
utility receiving the request to merge documents.

The Office Action alleges that “receiving, at the merge utility, a request to merge documents” is taught in *Schwier* by “the program code or device which enables the devices shown in Figure 1 to initiate a request to merge command.” However, it is not apparent how any element of FIG. 1 is “a request to merge documents.” Furthermore, the Office Action fails to allege how and when such a request is received “at the merge utility.” Nor does *Schwier* teach or suggest that “the steps of converting the second document and merging the first merge document and the second merge document are both performed **in response** to the merge utility receiving the request to merge document.”

As another example, Claim 9 features, among other elements:

passing [a] set of conversion instructions from the merge utility to the first document authoring application; and
 the first document authoring application generating the second merge document based on said set of conversion instructions.

The Office Action alleges that “passing [a] set of conversion instructions to a document authoring application” may be found in *Schwier*, col. 4, lines 15-20. However, this portion of *Schwier* does not show **a merge utility passing a set of instructions**, as Claim 9 presently recites. Even more specifically, Claim 9 requires that merge utility pass the instructions to the document authoring application **that created the second document**. *Schwier* does not disclose or suggest anything like this.

As another example, Claim 11 recites that “the composite merge document is in the merge format.” Thus, as defined by Claim 11, a composite merge document must be in the merge format, and must be delivered to the output device. The Office Action alleges that such a composite merge document is disclosed in *Schwier*, lines 56-67. However, these lines merely describe how a single document containing variable and static data is converted to EMF format (a non-merge format) that is subsequently separated into two documents prior to being converted to PCL (a merge format).

In fact, *Schwier* does not disclose a composite merge document within the meaning of Claim 11. The static data and the variable data are separated before they are converted into a PCL (or other printer-compatible) data stream. Prior to this time, the combination of static and variable data cannot be considered a composite merge document, because it is not in the merge format. Since merger of the separated static and variable data does not occur until after the data has been sent to the printer, no “composite merge document” is ever “delivered” to *Schwier*’s output device. Thus the merged document on the printer is also not a “composite merge document.”

As another example, Claim 12 recites that the “composite merge document is a template for creating other documents.” The Office Action alleges that *Schwier* discloses this feature by virtue of the fact that Figure 5 of *Schwier* shows a master document. However, the master document of Figure 5 in *Schwier* is not a composite merge document. While Figure 5 does show a master document, this master document is not merged from two documents in the merge format, as is a composite merge document. Rather, the master document of Figure 5 is created at a document authoring program, and will subsequently be separated into static data and

variable data. At no time does *Schwier* disclose a composite merge document behaving as a template.

To expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 2–28 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

III. CONCLUSION

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a check for the petition for extension of time fee and other applicable fees is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,
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